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Takehisa Kato

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EXAMINER

CALLAHAN, PAUL E

Pillsbury Winthrop LLP
Intellectual Property Group
1600 Tysons Boulevard
McLean, VA 22102

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 2137

DETAILED ACTION

1. Claims 25, 29, 32-36, 38, and 41-47 were pending at the time of the previous Office Action. By the latest amendment, filed 5-12-06, claim 25 has been cancelled. Therefore claims 29, 32-36, 38, and 41-47 remain pending and have been examined.

Allowable Subject Matter

2. The indicated allowability of claims 29, 38, 32-34, and 42 is withdrawn in view of a review of the parent and related applications. Obviousness-type double patenting rejections of the Claims are found infra.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 29, 38, and 42 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,347,145. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 1 of the Patent contains every element of claims 29, 38, and 42 of the instant application and as such anticipates claim 29, 38, and 42 of the instant application.

*"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim". In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).*

5. Claims 32-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4 and 6 respectively of U.S. Patent No. 6,347,145. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 4 and 6 of the Patent contain every element of claims 32-34 of the instant application and as such anticipate claims 32-34 of the instant application.

*"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim". In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re*

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Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Allowable Subject Matter

6. Claims 35, 36, 41, and 43-47 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter: The closest prior art in the field, Haas US 5,719,938, and Smith 6,823, 070, do not teach the features found in the independent claims of:

As for claim 35: recording at least a part of a number P of second keys, where p is an integer greater than or equal to two, in a secret area in a deciphering device; inputting first enciphered data obtained by enciphering data with a first key and second information composed of a p number of enciphered first keys obtained by enciphering the first key with the P number of second keys, respectively; and then deciphering at least one of the P number of enciphered first keys using the recorded P number of second keys to obtain said first key; and confirming that the obtained first key is correct; and then deciphering the enciphered data using the obtained first key after the confirmation step. The claim is distinguished from the teachings Smith in particular since Smith teaches an escrow system where the plurality of second keys are not

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stored in a common location until the caretaker seeks to recover the p number of enciphered first keys,

As for claim 36: a key control method wherein a first caretaker takes custody of a plurality of second keys; a second caretaker takes custody of first information composed of enciphered data obtained by enciphering data with a first key and second information composed of a P number of enciphered first keys, where P is an integer greater than or equal to two, obtained by enciphering said first key with a P number of second keys of said plurality of second keys, respectively, and a third caretaker that takes custody of at least part of said plurality of second keys, said at least part of said plurality of second keys being recorded in a secret area of a device provided by the third caretaker. The claims may be distinguished in particular from Smith since the claims do not teach the plurality p of second keys being stored at separate locations as with the dependent masks of Smith.

As for claim 41: storing a plurality of master keys, allocating at least part of the plurality of master keys to a player maker; receiving a session key supplied from a disk maker; selecting part of the plurality of master keys for use in enciphering the session key in a case where part of the plurality of master keys has been broken; enciphering the received session key with a selected part of the plurality of master keys to produce a plurality of enciphered session keys, and supplying the produced plurality of enciphered session keys to said disk maker. The claims may be distinguished in particular from

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Smith since the claims do not teach the plurality p of second keys being stored at separate locations as with the dependent masks of Smith,

As for claims 43, 46 and 47: a key control method applied to a key control organization, a disk maker, and a player maker. The claims may be distinguished from the teachings of Smith in particular since smith does not teach the features found in the claim of a player device provided a player maker with one or more master keys, and a disk supplied by a disk maker, and a third information obtained by enciphering a session key with itself.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Paul Callahan

8-2-06

